

DILLON YUDELL LLP
ATTORNEYS AT LAW

RECEIVED
CENTRAL FAX CENTER

APR 26 2004

OFFICIAL

USPTO FACSIMILE TRANSMITTAL SHEET

TO:	Mail Stop Appeal Brief - Patents	FROM:	Brian F. Russell
COMPANY:	US Patent and Trademark Office	DATE:	APRIL 26, 2004
ART UNIT:	2155	TOTAL NO. OF PAGES INCLUDING COVER:	46
FAX NUMBER:	703-872-9306	APPLICATION SERIAL NO:	09/534,592
		ATTORNEY DOCKET NO:	AUS000003US1

☐ URGENT ☐ FOR REVIEW ☐ PLEASE COMMENT ☐ PLEASE REPLY ☐ PLEASE RECYCLE

NOTES/COMMENTS:

Please see attached herewith:

☒ Appeal Brief (in triplicate) 45 pages.

This fax from the law firm of Dillon & Yudell LLP contains information that is confidential or privileged, or both. This information is intended only for the use of the individual or entity named on this fax cover letter. Any disclosure, copying, distribution or use of this information by any person other than the intended recipient is prohibited. If you have received this fax in error, please notify us by telephone immediately at 512.343.6116 so that we can arrange for the retrieval of the transmitted documents at no cost to you.

8911 N. CAPITAL OF TEXAS HWY., SUITE 2110, AUSTIN, TEXAS 78759
512.343.6116 (V) • 512.343.6446 (F) • DILLONYUDELL.COM

RECEIVED
CENTRAL FAX CENTER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APR 26 2004

In re Application of:
RABINDRANATH DUTTA

Serial No.: 09/534,592

Filed: 03/27/2000

For: **METHOD TO ELIMINATE BOOK
MARKING FALSE SERVERS**ATTORNEY DOCKET NO.: #8
AUS000003US1
LIT
5-6-04Examiner: **THU HA T. NGUYEN**

Art Unit: 2155

OFFICIAL

APPEAL BRIEF UNDER 37 C.F.R. 1.192Commissioner for Patents
Washington, D.C. 20231

Sir:

This Appeal Brief is submitted in triplicate in support of an Appeal of the Examiner's final rejection of December 1, 2003, in the above-identified application. A Notice of Appeal was filed in this case on February 24, 2004 and received in the patent office on February 24, 2004. Please charge the fee of \$320.00 due under 37 C.F.R. § 1.17(c) for filing the brief, as well as any additional required fees, to IBM Deposit Account No. 09-0447.

CERTIFICATE OF FACSIMILE TRANSMISSION	
37 C.F.R. § 1.806	
I hereby certify that this correspondence is being transmitted by facsimile on the below date to the United States Patent and Trademark Office at 703-293-1830.	
Date: 4/26/2004	Signature: STEPHEN J. DIARZ, Esq.

REAL PARTY IN INTEREST

The real party in interest in the present Appeal is International Business Machines Corporation, the Assignee of the present application as evidenced by the Assignment recorded at reel 010705 and frame 0803 *et seq.*

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, the Appellants' legal representative, or assignee, which directly affect or would be directly affected by or have a bearing on the Board's decision in the pending appeal.

STATUS OF CLAIMS

Claims 1-24 were originally presented. In Appellants' Amendment A, filed September 4, 2003, Claims 1, 5-6, 9, 13-14, 17 and 21-22 were amended. The amendments to independent claims 1, 9, and 17 comprise only changes in punctuation. Claims 1-24 stand finally rejected by the Examiner as noted in the Final Office Action dated December 1, 2003.

STATUS OF AMENDMENTS

Appellants' Amendment A, filed on September 4, 2003, was entered by the Examiner. No amendments to the claims have been proposed or entered subsequent to the final rejection that led to this appeal.

SUMMARY OF THE INVENTION

The present invention is directed to an improved technique of network management, in which the use of bookmarks to circumvent traffic-management servers is prevented. As is described at page 7, line 16 *et seq.*, in large server implementations, a central web server at a publicized URL redirects requests for files, on the basis of dynamically determined capacity utilization, to a number of servers holding identical content. Clients may attempt to directly access one of the content servers without first being redirected from a central load server, which, if permitted, would decrease the efficiency of load balancing. Accordingly, in the event that a

client attempts to access one of the content servers without first having been redirected from a load server, the client is redirected to a page containing a notice of the error, then redirected yet again to the load server. Facilities are also provided for correcting the bookmark entry that brought the user to a protected content server rather than to the central load server.

As is described at page 12, line 2 *et seq.* of the present specification and illustrated in Figure 1, a data processing system network in which a preferred embodiment of the present system may be implemented contains a number of servers 104 and 106 to provide web page content in response to requests from multiple clients 108 and 110. Identical copies 120 and 122 of the content reside on servers 104 and 106. By placing identical copies on multiple servers, a re-directing arrangement of load servers and content servers may be implemented, wherein a load distribution server receives requests for content and redirects requests for content to content servers 104 and 106. An individual client 110 will typically contain a web browser 114. Among its other constituent parts, the web browser may have a set of data files 116a through 116n, including the user's bookmarks 116n.

The innovative method by which the load distribution servers and content servers prevent circumvention of traffic-management servers is described at page 18, line 10 *et seq.* of the present specification and depicted in Figure 8. In the illustrated scenario, client 812 submits a file request 820 to the load distribution server 800 while client 806 submits a file request 816 via an impermissible bookmark to the first content server 802. The request 820 from client 812 is re-directed (826) to the first server 802, and the requested file 832 is sent. However, load distribution server 800 and content server 802 handle impermissible file request 816 in accordance with the process illustrated in Figure 5.

The process by which load distribution server 800 and content server 802 handle impermissible file request 816 works to insure that, in the case of the request 816 from the first client 806, the request 816, which was not sent through a load distribution server 800, is refused 836. This refusal occurs in the steps outlined with respect to Figure 5 at page 14, line 2 *et seq.* Because step 502 determines that the request did not originate as a reference from an load distribution server 800, the process proceeds to step 504 and the content server 802 determines

whether the request originated as a reference from the content server 802. In the case illustrated here, the file request from the client 806 originated as neither a reference from the load distribution server 800 nor as a reference from the content server 802 and the procedure of the preferred embodiment now moves to step 506, the first step of the refusal procedure 524. In step 506 the content server sends a file, generally in the form of a web page, informing the user to directly contact the load distribution server at the main, publicized URL. This same file or another file offers the user the opportunity to update his bookmark for that page in step 508.

As is described at page 16, line 1 *et seq.* of the present specification, if the user does desire to update his bookmark, then the procedure of the preferred embodiment continues to step 520, where the content server sends a file, typically a Java applet, containing instructions to edit the bookmark file to reflect the correct page. The modification could be achieved automatically, without any user input beyond requesting that the file containing instructions for the modification be sent to his machine.

As is described at page 17, line 1 *et seq.* of the present specification, either step 520 or step 508 will then lead to step 510, providing the user with a link containing the URL of the load distribution server and additional instructions for automatically redirecting the user's client to send a page request to the load distribution server after a given time. The procedure then calls for the instructions to wait (step 512) and determine whether the given time has expired (step 514), repeating this process cyclically until time has expired. When time has expired, the refusal procedure 524 completes and the client subsequently sends a redirected request to the load distribution server (step 516).

The process next moves to step 522, the load distribution server redirects the client to the content server and the process returns to step 500. This time, however, the question of step 502, determining whether the file request has originated as the result of a reference from an load distribution server 800, is answered in the affirmative and the requested file is sent.

As is described at page 20, line 11 *et seq.* of the present specification, after the refusal, the request of the client is rerouted 808 to the load distribution server 800. The load distribution

server reroutes the request 810 to the unused second content server 804, which sends the file 812 to the first client 806. This is portrayed in Figure 5 as step 522, where the load distribution server redirects the client to the content server and the process returns to step 500. This time, however, the question of step 502, determining whether the file request has originated as the result of a reference from an load distribution server 800, is answered in the affirmative and the requested file is sent.

As described above, the method of the present invention allows a content server and a load distribution server to determine whether a request for a file originated from an allowable source and to redirect a request that originated from an impermissible source. In determining if the source of a file request is allowable, a file request is considered allowable if the file request is a reference from a content server or a load distribution server, but the file request is impermissible if the source of the file request is a bookmark entry that points directly to a content server.

ISSUES

(1) Is the Examiner's rejection of Claims 1-3, 7-11, 15-19, and 23-24 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,185,598 to *Farber et al.* (*Farber*) well founded?

(2) Is the Examiner's rejection of Claims 4-6, 12-14, and 20-22 under 35 U.S.C. § 103(a) as unpatentable over *Farber* in view of U.S. Patent No. 5,813,007 to *Nielsen* (*Nielsen*) well founded?

GROUPING OF THE CLAIMS

For purposes of this Appeal, Claims 1-3, 7-11, 15-19, and 23-24 stand or fall together as Group I, and Claims 4-6, 12-14, and 20-22 stand or fall together as Group II.

ARGUMENT

In the Examiner's Final Office Action dated December 1, 2003, and labeled paper #6 Claims 1-3, 7-11, 15-19, and 23-24 of Appellant's application are rejected under 35 U.S.C. §

103(a) as unpatentable over U.S. Patent No. 6,185,598 to *Farber et al.* (*Farber*). That rejection is not well founded and should be reversed.

I. Group I claims

A. With respect to exemplary Claim 1 of Group I, no motivation exists within *Farber* or within that which was known to one skilled in the art to modify *Farber* in the manner suggested by the Examiner.

The Examiner has argued at Page 5 of the Final rejection, in support of his rejection of exemplary Claim 1 under 35 U.S.C. § 103(a), that it would have been obvious to one of ordinary skill in the data processing art at the time of Appellant's invention that *Farber* is equivalent to Appellant's invention. The Examiner argues this by noting that *Farber* implicitly discloses the original server (102) or a reflector (108) sending back to the client a redirect response, which contains a new URL and directs the client to contact with another server or repeater. The Examiner has further argued that these steps in *Farber* are equivalent to the step of sending to the client a file requesting that the client contact the load distribution server disclosed in Appellant's specification. The Examiner further observes that a person "of ordinary skill in the art would have recognized that *Farber* performs the same function in substantially the same way to reach substantially the same result." While the Examiner has attempted to recite the test for infringement under the doctrine of equivalents, infringement under the doctrine of equivalents is not the test for patentability during examination.

Appellant respectfully submits that the Examiner's assertion of the equivalence of the two methods, even if assumed to be correct, does not form a basis for a rejection for obviousness. Obviousness requires, rather than equivalence, that the prior art show some motivation for the modification necessary to obtain the claimed invention. "It is insufficient [to establish a *prima facie* case of obviousness] that the prior art disclosed the components of [the invention], either separately or used in other combinations; there must be some teaching, suggestion, or incentive

APPEAL BRIEF

Docket No. AUS000003US1

Page 6 of 15

to make the combination made by the inventor.” *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990). Appellant respectfully submits that, in arguing equivalence to show obviousness, the Examiner neglects the critical element of showing the motivation for modification, which can not be supplied by a supposed “equivalence” of steps.

B. *Farber* does not teach or suggest each element recited in exemplary Claim 1 of Group I.

1. *Farber* does not teach or suggest “determining whether the client’s request to receive a file from the content server originated as a reference from the load distribution server or as a reference from the content server itself.”

Further, Claim 1 recites multiple elements neither taught nor suggested by *Farber*. For example, *Farber* does not disclose “determining whether the client’s request to receive a file from the content server originated as a reference from the load distribution server or as a reference from the content server itself.” At page 4 of the Final Rejection, the Examiner cites Col. 7, line 56- Col. 8, line 25 of *Farber* as providing similar functionality. Appellant respectfully submits that the only mention of determining the source of a request occurs when the method disclosed in *Farber* “determines whether the sender (client 106) is a browser or a repeater” (Col. 7, line 58). *Farber* then looks at the nature of the data requested in its attempt to “determine whether the resource requested is repeatable” (Col. 8, line 3). Neither of these steps attempts to determine how the client’s request was referred to the content server. The first attempts to make a decision based on the whether the requesting entity is a browser or a repeater. The second attempts to determine the processing of the request based on the type of item requested.

Absent any objective evidence that *Farber* teaches or suggests “determining whether the client’s request to receive a file from the content server originated as a reference from the load distribution server or as a reference from the content server itself,” the Examiner’s rejection of exemplary Claim 1 should be reversed.

2. Farber does not teach or suggest "responsive to determining whether the client's request to receive a file from the content server originated as a reference from the load distribution server or as a reference from the content server itself, sending to the client a file requesting that the client contact the load distribution server."

Also with respect to Claim 1, the Examiner correctly observes that *Farber* does not explicitly teach the step of sending to the client a file requesting that the client contact a load distribution server (Final Office Action, page 7), but argues that *Farber* "substantially teaches the original server (102) or a reflector (108) sends back to the client a redirect response which contains a new URL that the client contact with another server (figure 2, col. 7, lines 19-col. 8 lines 67)". Appellant respectfully submits that the lengthy citation to *Farber* does not teach, "responsive to determining whether the client's request to receive a file from the content server originated as a reference from the load distribution server or as a reference from the content server itself, sending to the client a file requesting that the client contact the load distribution server." While *Farber* does mention the use of a redirect message (col. 7, line 32), *Farber* makes no disclosure of the conditional structure that triggers the redirect message. Appellant respectfully submits that the Examiner impermissibly reasons outside the reference by asserting that *Farber* teaches the recited functionality, because *Farber* does not disclose the determining step discussed above. *Farber* also fails to disclose any claimed step conditioned on or acting "responsive to" such a "determining" step.

II. With respect to the Group II claims, the Examiner provides no motivation from within the references or from within that which was known to one skilled in the art at the time that the invention was made to combine *Farber* and *Nielsen*.

In the Examiner's Final Office Action dated December 1, 2003, the Examiner also rejected Claims 4-6, 12-14, and 20-22 rejected under 35 U.S.C. § 103(a) as unpatentable over *Farber* in view of U.S. Patent No. 5,813,007 to *Nielsen* (*Nielsen*). That rejection is not well founded and should be reversed.

APPEAL BRIEF
Docket No. AUS000003US1
Page 8 of 15

As set forth in MPEP 2143 and was discussed with respect to Group I, the first criterion for establishing a *prima facie* case of obviousness is that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to...combine reference teachings." In evaluating motivation or suggestion to combine reference teachings, "a prior art reference must be considered in its entirety, i.e., as a whole" (emphasis in original). MPEP 2141.02, citing *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir 1983) *cert. denied*, 469 U.S. 851 (1984).

When taken as a whole, *Farber* discloses a system for redirecting file requests among a series of repeaters in response to a request for a file being sent by a client. *Nielsen*, on the other hand, describes a system for updating the bookmarks stored on the client system in response to changes in the content of a file on the file server. In view of the teachings of the references as taken as a whole, it is apparent that there is no objective suggestion or motivation in the cited references (or generally in the art) that would lead a skilled artisan to combine the reference teachings to obtain the present invention. If such suggestion or motivation existed, the Examiner would have, no doubt, cited by column and line number a passage in one of the references cited or a well known teaching in the art to discharge his duty to "explain why the combination of the teachings is proper." MPEP 2142, citing *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. Appl. & Inter. 1986). Instead, at page 8 of the first office action, the Examiner merely asserts:

It would have been obvious to one of ordinary skill in the Data Processing art at the time of the invention to combine the teachings of *Farber* and *Nielsen*....because it would have been an efficient communications system.

The Examiner alleges that "it would have been an efficient communications system." Unfortunately, the Examiner provides no citation to where this alleged advantage of efficiency is taught in the references; no such teaching exists. Similarly, the Examiner does not even bother

to explain or define the 'efficiency' that he alleges. Does he assume that this efficiency is likewise obvious to one skilled in the art? If the efficiency advantage were taught in one of the references, Appellant could then, at least, evaluate the veracity of the allegation. Instead, the Examiner's oblique and unsupported reference to efficiency requires naked acceptance, because no support is provided for evaluation.

The Examiner has argued an advantage not taught or suggested by the references. Because the Examiner's combination of references is not supported by any objective teaching in the references or art, Appellant believes that the examiner has failed to establish a *prima facie* case of obviousness.

CONCLUSION

Appellants have pointed out with specificity the manifest error in the Examiner's rejections, and the claim language which renders the invention patentable over the combination of references. Appellants, therefore, respectfully request that each rejection be reversed and that the Examiner be instructed to issue a Notice of Allowance with respect to all pending claims.

Respectfully submitted,



Brian F. Russell
Reg. No. 40,796
DILLON & YUDELL LLP
8911 North Capital of Texas Highway
Suite 2110
Austin, Texas 78759
512-343-6116

ATTORNEY FOR APPELLANTS

APPEAL BRIEF
Docket No. AUS000003US1
Page 10 of 15

APPENDIX

1. A method of preventing a client from directly contacting a server that is protected by a load distribution server from an overload of traffic, comprising:

determining whether the client's request to receive a file from the content server originated as a reference from the load distribution server or as a reference from the content server itself; and

responsive to determining that the client's request to receive the file from the content server did not originate as the reference from the load distribution server or as the reference from the content server itself, sending to the client a file requesting that the client contact the load distribution server.

2. The method of Claim 1, further comprising:

responsive to determining that the request to receive the file from the content server did originate as the reference from the load distribution server or as the reference from the content server itself, sending to the client the file requested.

3. The method of Claim 1, further comprising:

including in the file requesting that the client contact the load distribution server a means by which the client may directly contact the load distribution server through an initiative of a user of the client.

4. The method of Claim 1, further comprising:

offering in the file requesting that the client contact the load distribution server a means to update a bookmark file to include the load distribution server.

5. The method of Claim 4, further comprising:

offering in the file requesting that the client contact the load distribution server a means to update the bookmark file to exclude the content server.

APPEAL BRIEF

Docket No. AUS000003US1

Page 11 of 15

6. The method of Claim 4, further comprising:
offering in the means to update the client's bookmark file to include the load distribution server a means to update the bookmark file to exclude the content server.
7. The method of Claim 1, further comprising:
including in the file requesting that the client contact the load distribution server a means by which the client will contact the load distribution server without intervention of the user.
8. The method of Claim 7, further comprising:
including in the file requesting that the client contact the load distribution server a means by which to allow the user of the client sufficient time to read and react to the file requesting that the user of the client contact the load distribution server before contact with the load distribution server is established without intervention of the user.
9. A computer program product for preventing a client from directly contacting a server that is protected by a load distribution server from an overload of traffic, comprising:
instructions for determining whether the client's request to receive a file from the content server originated as a reference from the load distribution server or as a reference from the content server itself; and
instructions for, responsive to determining that the client's request to receive the file from the content server did not originate as the reference from the load distribution server or as the reference from the content server itself, sending to the client a file requesting that the client contact the load distribution server.
10. The computer program product of Claim 9, further comprising:
instructions for, responsive to determining that the request to receive the file from the content server did originate as the reference from the load distribution server or as the reference from the content server itself, sending to the client the file requested.

11. The computer program product of Claim 9, further comprising:
instructions for including in the file requesting that the client contact the load distribution server a means by which the client may directly contact the load distribution server through an initiative of a user of the client.
12. The computer program product of Claim 9, further comprising:
instructions for offering in the file requesting that the client contact the load distribution server a means to update a bookmark file to include the load distribution server.
13. The computer program product of Claim 12, further comprising:
instructions for offering in the file requesting that the client contact the load distribution server a means to update the bookmark file to exclude the content server.
14. The computer program product of Claim 12, further comprising:
instructions for offering in the means to update the client's bookmark file to include the load distribution server a means to update the bookmark file to exclude the content server.
15. The computer program product of Claim 9, further comprising:
instructions for including in the file requesting that the client contact the load distribution server a means by which the client will contact the load distribution server without intervention of the user.
16. The computer program product of Claim 15, further comprising:
instructions for including in the file requesting that the client contact the load distribution server a means by which to allow the user of the client sufficient time to read and react to the file requesting that the user of the client contact the load distribution server before contact with the load distribution server is established without intervention of the user.

17. A system of preventing a client from directly contacting a server that is protected by a load distribution server from an overload of traffic, comprising:

means for determining whether the client's request to receive a file from the content server originated as a reference from the load distribution server or as a reference from the content server itself;

means for, responsive to determining that the client's request to receive the file from the content server did not originate as the reference from the load distribution server or as the reference from the content server itself, sending to the client a file requesting that the client contact the load distribution server.

18. The system of Claim 17, further comprising:

means for, responsive to determining that the request to receive the file from the content server did originate as the reference from the load distribution server or as the reference from the content server itself, sending to the client the file requested.

19. The system of Claim 17, further comprising:

means, included in the file requesting that the client contact the load distribution server, by which the client may directly contact the load distribution server through an initiative of a user of the client.

20. The system of Claim 17, further comprising:

means, offered in the file requesting that the client contact the load distribution server, to update a bookmark file to include the load distribution server.

21. The system of Claim 20, further comprising:

means, offered in the file requesting that the client contact the load distribution server, for updating the bookmark file to exclude the content server.

22. The system of Claim 20, further comprising:
means, offered in the means for updating the client's bookmark file to include the load distribution server, for updating the bookmark file to exclude the content server.
23. The system of Claim 17, further comprising:
means, included in the file requesting that the client contact the load distribution server, by which the client will contact the load distribution server without intervention of the user.
24. The system of Claim 23, further comprising:
means, included in the file requesting that the client contact the load distribution server, by which to allow the user of the client sufficient time to read and react to the file requesting that the user of the client contact the load distribution server before contact with the load distribution server is established without intervention of the user.